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Fani Malikouzakis

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s)	:	Myron JACOBSON et al.
Serial No.	:	09/973,451
Filed	:	October 9, 2001
For	:	GENES ENCODING SEVERAL POLY (ADP-RIBOSE) GLYCOHYDROLASE (PARG) ENZYMES, THE PROTEINS AND FRAGMENTS THEREOF, AND ANTIBODIES IMMUNOREACTIVE THEREWITH
Group	:	1635
Examiner	:	Karen A. LACOURCIERE

March 17, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT AND AMENDMENT

Sir:

Responsive to the restriction requirement of February 25, 2004, applicants elect antibodies that bind to HUMAN protein. This is SEQ ID NO: 3, Group VI, claims 67, 69 and 71.

Applicants do NOT understand why claims 70, 73, 74, 76, and 78 are not included in this group. All read on elected claim 67, through SEQ ID NO: 3.

Applicants also do not understand why (i) the fact that a prior restriction requirement issued, and was answered, is not addressed, nor do they understand why the

issues set forth in THIS restriction requirement were not set forth in the first restriction requirement. This application has been pending for nearly 2½ years. Surely substantive action ought to have began. Instead, the prosecution has been delayed further by the USPTO.

The Examiner refers to "the heavy search burden placed on the office" if more than one sequence is examined.

With all due respect, this argument is fallacious. The great grandparent application of the present case has issued. All sequences were examined therein. The prior art was already considered. How, then, can there be a "heavy" search burden, if the search was already done? It is of course recognized that antibodies are being claimed rather than proteins; however, the USPTO itself has taken the position that the patentability of proteins and antibodies to them are linked. See *Ex parte Erlich*, 3 USPQ2d 1011 (PTO Bd. Pat. App. & Int. 1987); *In re Jochim*, 11 USPQ2d 1561 (PTO Bd. Pat. App. & Int. 1988).

Please amend the application as follows: